IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants: | Eric C. Hannah et al. | § | Group Art Unit: | 3688 |
| | | § | | |
| Serial No.: | 09/690,512 | § | Examiner: | Jean D. Janvier |
| | | § | | |
| Filed: | October 17, 2000 | § | Attorney Docket.: | ITL.0482US |
| | | § | | P10030 |
| For: | Ensuring that | § | | |
| | Advertisements are Played | § | Conf. No.: | 3230 |

Mail Stop **Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## PETITION UNDER 37 C.F.R. § 1.181

Dear Sir:

**Issue Raised**

Can the Examiner re-raise a non-prior art issue after one, much less two, reversals by the Board of Appeals?

**Background Facts**

The present application has gone on appeal twice. Each time the Examiner's rejections have been reversed. The Examiner has already been reversed under the Section 101 rejection, but, nonetheless, the Examiner re-raises a Section 101 rejection after reversal by the Board of Appeals.

**Argument**

The Manual of Patent Examining Procedure does not permit reopening prosecution for anything other than the discovery of the new prior art. See M.P.E.P. § 1214.04. Thus, the only basis for raising new rejections is finding a new reference. No new reference was found with respect to the Section 101 rejection and it is improper for this additional reason. In

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addition, the asserted basis for the Section 101 rejection is improper. See *Ex parte Bo Li*, appealed 2008-12-13, decided November 6, 2008 at page 7.

> Therefore, we also conclude that the "useful, concrete intangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply. [Footnote: As a result, those portions of our opinions in State Street and AT&T relying solely on a "useful, concrete intangible result" analysis should no longer be relied on. *In re Bilski*, case 2007-1130, page 20 (Fed. Cir., October 30, 2008)].

Likewise, the rejection of claims 21 *et seq.* over exactly the same art which has already been examined by the Board is improper. There is no authority for reopening of prosecution as to a claim over art that has already been considered. Again, the only basis for reopening prosecution is finding a new reference. See M.P.E.P. § 1214.04.

**Summary**

The reopening of prosecution to re-raise issues already adversely decided by the Board and in the absence of finding of a new reference is not permitted and supervisory authority should be exercised. For reasons already of record in the case, the rejections are totally baseless.

Respectfully submitted,

Date: September 2, 2009

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